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09/516,648	03/01/2000	Roger P Hoffman	P/2-61	3239

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER	13
		1773

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/516,648	HOFFMAN, ROGER P
Examiner	Art Unit	
Kevin R Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on March 25, 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-5 and 7-28 is/are pending in the application.
4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-5 and 7-23 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . 6) Other: ____ .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "high quality graphics" is indefinite. The term is not defined in the specification, nor does the term have an art accepted meaning. Applicant must amend the claim, show where the term is defined in the original disclosure, or provide the Office with a reference that defines the term and predates the prior date of the current Application.

Applicant has provided the Office with references that utilize the term "high quality graphics" in their written description. However, the references fail to clarify the record of the current application by defining the metes and bounds of the term. Thus, the rejection is maintained.

2. The rejection of claim 6 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome by the cancellation of claim 6.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "publication grade paper" is indefinite. The term is not defined in the specification, nor does the term have an art accepted meaning.

Applicant must amend the claim, show where the term is defined in the original disclosure, or provide the Office with a reference that defines the term and predates the prior date of the current Application.

Applicant has provided the Office with references that utilize the term "publication grade paper" in their written description. However, the references fail to clarify the record of the current application by defining the metes and bounds of the term. Thus, the rejection is maintained.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "label stock grade" is indefinite. The term is not defined in the specification, nor does the term have an art accepted meaning. Applicant must amend the claim, show where the term is defined in the original disclosure, or provide the Office with a reference that defines the term and predates the prior date of the current Application.

Applicant has provided the Office with references that utilize the term "label stock grade" in their written description. However, the references fail to clarify the record of the current application by defining the metes and bounds of the term. Thus, the rejection is maintained.

5. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim contains an improper Markush group.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4, 7-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173). Cavagna teaches outer packaging materials are made of paperboard comprising unbleached kraft paperboard that has been surface treated on at least one side with a white coating or the like. The white coating may be applied as a thin layer of high quality label paper (col 1, lines 10-29).

Cavagna does not teach that the paperboard should further comprise a top ply overlying said white layer. However, Peer teaches a plastic film that can be applied over outer packaging paper materials. The plastic film provides tear resistance to the composite and may be reverse printed on their inner surface (abstract). The plastic film is selected from the group consisting of polyethylene, polypropylene, and PET (abstract). Therefore, the examiner takes the position that it would have been obvious to one of ordinary skill in the art to apply the adhesive/plastic layer taught in Peer to the outer packaging taught in Cavagna in order to improve the tear resistance of the packaging.

With respect to claim 3, Cavagna does not explicitly teach what materials may be utilized in the production of the paperboard layer. However, Peer teaches that outer

packaging is usually made from kraft pulp or recycled paper pulp (col 5, lines 11-50). Thus, it would have been obvious to one of ordinary skill in the art to make the paperboard taught in Cavagna from either virgin kraft pulp or recycled pulp because Peer teaches said materials are traditionally used in the production of outer packaging.

With respect to claim 2, the examiner takes the position that the graphics produced using the adhesive/polymer overlay taught in Peer are "high quality" since they are sufficient for consumer appeal. The examiner further takes the position that the polymer ply taught in Peer meets the "enhanced smoothness" limitation of claim 6 because Peer teaches the top ply should be smooth (col 3, line 20). The examiner also takes the position that any adhesion would meet the "barrier for moisture, oil and odor" limitation of claim 7 because any substance will restrict moisture, oil, and odor transmission to some extent.

The examiner takes the position that the laminate taught in Cavagna meets the limitations of claim 4. Specifically, Cavagna teaches a paperboard coated with a "thin" paper layer. Paperboard is generally understood to refer to cellulose fiber materials that are thicker than paper (see definition of "paperboard" from Merriam Webster's Collegiate Dictionary). With respect to claim 8, the examiner takes the position that the label grade paper taught in Cavagna is a publication grade paper. The examiner relies upon Applicant's disclosure on page 11 of the specification (last paragraph) where label grades are listed as a type of publication grade paper.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-

10, 12, and 13. Cavagna in view of Peer is relied upon as above, but neither reference teaches that the label paper should have a brightness of above 60ISO. However, it is known in the art to increase the brightness of a printing/imaging paper in order to enhance the image clarity. The courts have held that "When the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Thus, it would have been obvious to one of ordinary skill in the art to increase the brightness of the label paper taught in Cavagna in order to enhance the image clarity of the resulting secondary package material.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13, and further in view of Holder Jr. (US 3,982,056). Cavagna in view of Peer is relied upon as above, but does not teach that the label paper may be coated with clay, protein, starch, or titanium dioxide. However, Holder Jr teaches that label papers have conventionally had a liquid coating composition applied to one surface in order to improve the printable characteristics of the paper (col 1, lines 7+). Such coating compositions include starch, clay, casein, and TiO₂. Thus, it would have been obvious to one of skill in the art to apply any of clay, casein, TiO₂, or starch to the surface of the label paper taught in Cavagna in order to improve its printability.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13 above. Cavagna in view of Peer is relied upon as above.

Specifically, Peer teaches that the plastic layer provides the laminate with an "attractive appearance" (col 8, lines 53+) but does not teach that the tear resistant film may be pigmented. However, the court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. (*In re Seid* , 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

Thus, the examiner takes the position that it would have been obvious to one of ordinary skill in the art to apply pigment to the tear resistant film taught in Peer in order to obtain the desired aesthetic effect.

10. Claims 15, and 17-19 are rejected under Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13 above, and further in view of Confer (US 3,603,501). Cavagna in view of Peer is relied upon as above. Cavagna teaches that the paperboard core may be finished on both surfaces with a label paper (col 1, line 20). The examiner takes the position that an inner label paper would read on the claimed moisture absorbent layer. Cavagna does not teach that such label papers are adhered to the paperboard core. However, Confer teaches that secondary packaging materials are generally made by adhering the label paper to the paperboard core (col 3, lines 1-20). Thus, it would have been obvious to one of ordinary skill in the art to apply adhesive between the label paper and the paperboard core taught in Cavagna because Confer teaches that such a laminating technique is the traditional method by which secondary packaging is processed. The examiner takes the position that any adhesive is a barrier to moisture to some extent.

11. Claims 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13 above, and further in view of Knudson et al. (US 4,913,773). Cavagna in view of Peer is relied upon as above, but neither reference teaches that the paperboard core may comprise more than one layer of paperboard. However, Knudson teaches a multi-ply paperboard comprising one ply of high bulk fibers sandwiched between at least two plies of conventional papermaking fibers (abstract). A bonding agent may be utilized between the layers (col 5, lines 3-17). Said paperboard has superior stiffness in comparison to traditional paperboard. Stiffness is important in folding carton applications (col 3, lines 3-5). Thus, it would have been obvious to one of ordinary skill in the art to utilize the multiply paperboard taught in Knudson in the laminate taught in Cavagna to increase the stiffness of the laminate.

With respect to claims 15-19, the examiner takes the position that the second and third layers of the multiply paperboard read on the claimed unbleached pulp and absorbent layer, respectively. The bonding layer reads on the claimed moisture barrier layer.

Response to Arguments

Applicant's arguments with respect to claims 1-5 and 7-23 have been considered but are moot in view of the new ground(s) of rejection. The rejection of claims 15-19 are rejected under Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173) and further in view of Hall (US 4,441,626) has been overcome by argument.

Applicant argues that the rejection of Cavagna in view of Peer fails to render the claimed invention obvious. The examiner respectfully disagrees. The examiner initially notes that both patents are drawn to the same field of endeavor, secondary container packaging. The examiner notes that Peer would have motivated one of ordinary skill in the art to apply the film and adhesive layers to the laminate taught in Cavagna in order to improve the tear resistance of the packaging. While Applicant argues that Cavagna does not disclose that the taught film is deficient with regards to tear resistance, the examiner notes that a *prima facie* case of obviousness does not require the primary reference to note such a deficiency. Rather, a claim is obvious if one of ordinary skill in the art, taking into account the teachings of the prior art as a whole, would have been motivated to make the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

X-RK
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Paul Thibodeau
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